cited by the Examiner.

Claims 1-6 and 11-12 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 4-6, and 12-13 of copending application 08/908,129. Specifically, the Examiner alleges that "[t]he only difference is in the substitution of 'scan-wise exposing' in the instant claims in place of 'image-wise exposing' and the order of the language. The claims seek coverage of exactly the same scope." Applicants respectfully disagree.

Claims 1-6 and 11-12 do not claim the identical subject matter of claims 1, 4-6, and 12-13 of copending application 08/908,129. Therefore, the provisional rejection under 35 U.S.C. 101 is not valid (see MPEP 804 II-A). For example, claim 1 of the present application requires, *inter alia*, "a support surface," whereas claim 1 of copending application 08/908,129 requires, *inter alia*, "a **flexible support** carrying a surface." Accordingly, Applicants respectfully request withdrawal of the provisional rejection under 35 U.S.C. 101.

Claims 1-8 and 10-12 are provisionally rejected under the judicially created doctrine of double patenting over claims 1 and 3-13 of copending application 08/908,129. A Terminal Disclaimer is included with this response in order to overcome the provisional rejection.

Claims 1, 4, 6, 7, and 11-12 are rejected under 35 U.S.C. 103 as being unpatentable over either Saikawa et al., "Saikawa,"

2

or Monbaliu et al., "Monbaliu," in view of Stoffel et al., "Stoffel." Claims 1, 4, 5, 7, and 11-12 are rejected under 35 U.S.C. 103 as being unpatentable over Peterson in view of Stoffel. Applicants respectfully traverse these rejections.

The 35 U.S.C. 103 rejections are based on the unsubstantiated assertion that "[i]t would have been obvious to one skilled in the art to include frequency modulation screening techniques such as error diffusion taught by Stoffel et al. '(1981) in the techniques of producing printing plates" disclosed by Saikawa, Monbaliu, or Peterson, "with a reasonable expectation of gaining the benefits taught by Stoffel et al. '(1981), based upon the disclosure of Stoffel et al. '(1981) that this technique is applicable to lithography." Applicants respectfully disagree with the Examiner's conclusion.

Saikawa, Monbaliu, and Peterson disclose various techniques for making and/or imaging lithographic printing plates. Saikawa, Monbaliu, and Peterson, however, are completely silent with regard to the use of frequency modulation screening. The Examiner relies on the alleged teachings of Stoffel to overcome this deficiency in Saikawa, Monbaliu, and Peterson.

Stoffel does not teach or suggest that the benefits provided by error diffusion are specifically applicable to lithographic printing. Indeed, Stoffel only discloses (page 1907, right column) that error diffusion can be applied to computer output microfilm (COM) and binary displays. There is **absolutely no**

3

disclosure regarding lithography in the sections of Stoffel directed to error diffusion, and absolutely no disclosure of how any benefits of error diffusion could, if at all, be utilized in lithography. Therefore, contrary to the allegations of the Examiner, one of ordinary skill in the art would not be motivated to apply error diffusion to lithography, based on the teachings of Stoffel.

Stoffel states in section B, page 1899, that "[a]lthough lithography, xerography, etc., have different microstructural characteristics, the algorithms investigated below are compatible in varying degrees with all of them." This statement, however, without any specific discussion of the applicability of, and benefits provided by, the various disclosed algorithms to the various output processes, and specifically to lithography, is merely an unsupported generalization. Thus, one of ordinary skill in the art would not be motivated by such an unproven statement to utilize a frequency modulation screening (e.g., Stoffel's error diffusion) to make a lithographic printing plate as set forth in the claims of the present invention. In other words, it would not be "obvious to try" the error diffusion of Stoffel upon the lithographic material of Saikawa, Monbaliu, or Peterson, absent some specific teaching (e.g., benefit, advantage, etc.) disclosed by Stoffel that would motivate one of ordinary skill in the art to do so. Such a teaching that specifically links the use of, and benefits provided by, error

4

diffusion with lithography, is nonexistent in Stoffel.

Applicants have discovered that various advantages, not previously disclosed, suggested, or recognized in the prior art, are provided by using frequency modulation screening in lieu of conventional techniques (e.g., the autotypical screening of Monbaliu) to make lithographic printing plates. For example, as disclosed on page 5, lines 2-19, of the disclosure, the use of frequency modulation screening allows an accurate proof to be generated using low cost, low complexity, and low resolution systems. None of the references cited by the Examiner teach or suggest that such an advantage is provided through the use of frequency modulation screening with lithographic printing plates. In fact, **Stoffel fails to disclose any advantages associated with the use of frequency modulation screening with lithographic printing plates.**

Claims 1 and 4-12 are additionally rejected under 35 U.S.C. 103 as being unpatentable over either Saikawa, Peterson, or Monbaliu in view of Stoffel, Harper's Dictionary of the Graphics Arts (1963), "Harper's," Evans et al., "Evans," and Ellis et al., "Ellis." Applicants respectfully traverse this rejection for reasons similar to those set forth above.

Accordingly, Applicants respectfully submit that claims 1-8 and 10-12 are allowable.

If the Examiner believes that any further discussion of the invention would be helpful, perhaps in the form of an Examiner's

5

Amendment, Applicants' representative is available at (518) 220-1850, and earnestly solicits such discussion.

Respectfully submitted,

John A. Merecki

By: John A. Merecki   Date: 8/10/99
Reg. No. 35,812
Schmeiser, Olsen & Watts
3 Lear Jet Lane, Suite 201
Latham, NY 12110
(518)220-1850